

Appl. No. 10/010,391
Atty. Docket No. 8384R
Amdt. dated December 6, 2004
Reply to Office Action of September 8, 2004
Customer No. 27752

REMARKS

Claims 1, 2, 5-8, 11, 13-16 and 18 are pending in the present application. No additional claims fee is believed to be due.

The specification has been amended to provide support for a claim limitation in claim 15. Support for the amendment can be found in the specification as exemplified by claim 15 as originally filed.

Claim 11 has been amended to put the claim in better form for appeal. Support for this amendment can be found in the specification as exemplified by, page 8, lines 28-30, page 9, lines 1-5, and page 21, lines 1-8.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 112, First Paragraph

The Office Action States that claim 15 is rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Applicants have amended the specification on page 4 such that claim 15 is described within the detailed description of the specification.

Rejection Under 35 USC 112, Second Paragraph

The Office Action has rejected claim 11 under 35 U.S.C. § 112, second paragraph, because the claim terms "may be formed" are considered vague and indefinite. In order to place claim 11 in better form for appeal, Applicants have replaced the claim terms "may be formed" with the terms "are formed".

Rejection Under 35 USC 103(a) Over Richards et al. in view of Hamilton et al. and W.E. Meissner

Meissner

Claims 1, 2, 5-8, 11, 13-16, and 18, have been rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 4,869,049 issued to Richards et al., hereafter "Richards", in view of U.S. Patent No. 5,662,758 issued to Hamilton et al., hereafter "Hamilton", and U.S. Patent No. 3,111,796 issued to W.E. Meissner, hereafter "Meissner".

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In order to establish a *prima facie* case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.* Applicants respectfully traverse the rejection by the Office Action because there is no motivation to make the suggested combination of references.

In support of its rejection, the Office Action provides:

Richards discloses an apparatus comprising: a body formed by an inner core having an inlet opening and an outlet opening and a passageway there between (figures 1, 4 & 5); a casing 1 comprising a surrounding casing wall, a storage space to retain a length of the flexible tubular sheet 2 within the storage space in a layered stack; the tubular sheet is gathered and closed at each end to form a closed packaged article 35 (figure 1); a means 61 comprises a slot for separating the closed packaged article; and the cutting blade 64 (figure 6)....

W. E. Meissner discloses, in an invention for closing and sealing a container, that: 'for closing and sealing a collapsible container by rupturing a bubble of tacky film-forming material at least within the opening end of the container as that portion of the container is urged into collapsed position' (column 1, lines 31-35). Figure 5 further depicting the closing and sealing of a flexible bag by twisting the bag at the area 53. During this twisting operation, the bubble ruptured and coated the inner wall of the bag with adhesive (column 5, lines 48-55).

Hamilton discloses a flexible film having pressure sensitive adhesive protected from inadvertent adherence (abstract); the flexible film having a recessed pressure sensitive adhesive and collapsible protrusions (three-dimensional film) which serve as stand-offs to prevent premature sticking to wide variety of rigid and resilient target surfaces, wherein the collapsible protrusions are small and closely spaced for releasable sealing of the composite material to such surfaces or even to itself (column 3, lines 20-26).

W E. Meissner's teaching provides a motivation for the practitioner in the art to find a flexible material to use as a bag in which the inner surface is coated with adhesive,

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and when pressure is applied such as twisting, the adhesive material ensures the sealing of the closure of the bag.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Richards' tubular sheet by applying the flexible film with adhesive as taught by Hamilton providing an effective dosing and sealing of the waste article in which the flexible material having pressure sensitive adhesive that is protected from inadvertent adherence to other surfaces.

(Office Action pages 3-4).

First, the Office Action asserts that Meissner provides a motivation to add an adhesive to a flexible material or container to insure the sealing and the closure of a bag while Richards teaches away from the addition of adhesive to the sealing of its pleated tubing. Caselaw provides that "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *See United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966). The MPEP section 2143.01 states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

Richards teaches that a top of a pleated tubing is pulled upward and tied into a knot thereby forming a bottom of a package. (col. 3, lines 11-14). Richards further teaches that after the articles are placed within the tubing, the tubing is twisted such that a seal is formed. (col. 3, lines 55-60). Richards also teaches the use of high density polyethylene in order to tightly maintain knots that are created. (col. 3, lines 55-60). Thus, Richards teaches methods and material which insure the sealing and the closing of the pleated tubing without the use of adhesives. Therefore, one skilled in the art, after reading the Richards reference, would be discouraged from utilizing adhesive in sealing or closing the pleated tubing of Richards.

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Second, the proposed modification of Meissner and Richards would render Richards unsatisfactory for its intended purpose. While the Office Action states that Meissner provides the motivation to add adhesive to the pleated tubing of Richards, the MPEP § 2141.02 provides that “[a] prior art reference must be considered in its entirety... including portions that would lead away from the claimed invention.” § 2141.02 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)). Furthermore, it is well established that, “[i]f the proposed prior art would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

An objective of Richards is to avoid complicated mechanical devices. (col. 1, lines 47-49). In contrast, however, Meissner teaches the addition of adhesive to insure the sealing and closure of a container via complex machines and processes. Meissner teaches that in order to insure sealing and closure of a container, an adhesive “is suspended within the open end of a container, expanded into the form of a bubble, and then ruptured concomitantly as the open end of the container is collapsed.” (col. 2, lines 3-6). Meissner further teaches that “[c]ontrol over the areas of the container walls coated with the adhesive film-forming material may be achieved by selectively positioning the expanded bubble or bubbles of film-forming material relative to the open end of the container.” (col. 2, lines 30-34). A mechanical device is required to suspend the adhesive within the open end of the container, and another mechanical device is possibly necessary to expand the adhesive into the form of a bubble. Therefore, the addition of adhesive to insure the sealing and the closure of the pleated tubing of Richards via the process disclosed in Meissner would greatly complicate the sealing and closure of the pleated tubing as disclosed in Richards. Thus, the addition of adhesive to seal or close the pleated tubing of Richards would contravene the intended purpose of Richards, and therefore, there is no motivation to combine Meissner with Richards.

Third, Meissner also renders the flexible film of Hamilton unsatisfactory for its intended purpose. One of the listed purposes of Hamilton is “to provide a composite material having a recessed pressure sensitive adhesive layer and collapsible protrusions which serve as stand-offs to prevent premature sticking to a wide variety of rigid and

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resilient target surfaces." (col. 3, lines 19-24)(emphasis added). Hamilton discloses a composite material which is capable of contacting a target surface without sticking.

In contrast, Meissner teaches a method of closing and sealing containers utilizing "a mass or gob of film-forming material is suspended within the open end of a container." (col. 2, lines 1-4). The gob or mass of film-forming material is "expanded into the form of a bubble, and then ruptured concomitantly as the open end of the container is collapsed." (col. 2, lines 3-5). However, "prior to the rupture of the expanded bubble of film-forming material, the bubble is deformed into conformity with the adjacent surfaces of the container walls and thereby progressively lines the same with a continuous adhesive coating." (col. 2, lines 9-13). The bubble eventually ruptures under the pressure supplied by the collapsing ends of the container. (col. 4, lines 50-53). The collapsing ends of the container are further urged together until the ends are pressed together. (col. 4, lines 55-58). However, because the container ends are coated with adhesive, once the container ends come into contact with the target surface, they stick. Moreover, Meissner does not disclose any mechanism for precluding the premature sticking of a container end to a target surface. Therefore, the adhesive application disclosed in Meissner does not preclude the container ends from prematurely sticking to a target surface. Because the application of adhesive as disclosed in Meissner encourages rather than precludes premature sticking to a contact surface, Meissner contravenes the intended purpose of Hamilton. Therefore, there is no suggestion or motivation to combine Meissner and Hamilton.

Fourth, Meissner, would change the principle of operation of the prior art invention being modified, i.e. Hamilton. Caselaw provides that, "[i]f the proposed modification of combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

Hamilton teaches that when the collapsible protrusions of the composite material are pressed they collapse such that a pressure sensitive adhesive is exposed to a target surface. (cols. 4-5, lines 65-67; 1-2). Thus, even when the composite material is in contact with a target surface, no adhesive is in contact with the target surface. Only after

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the collapsible protrusions are in fact depressed does the adhesive contact the target surface.

In contrast, as discussed previously, Meissner teaches that a collapsible expanded bubble of film-forming material can provide a continuous coating of adhesive to the adjacent surfaces of a container. (col. 2, lines 5-14). However, because the container ends are coated with adhesive, once the container ends come into contact with a target surface, they stick. Meissner does not teach that further compression is necessary to insure that the applied adhesive contacts the target surface. Thus, the principle operation of the Hamilton is different than the operation of the sealing of a container as disclosed Meissner. Therefore, there is no motivation to combine Meissner and Hamilton.

For the foregoing reasons, there is no motivation to make the suggested combination of references. Therefore, the Office Action has failed to establish a *prima facie* case of obviousness.

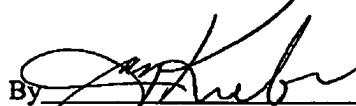
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC § 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 2, 5-8, 11, 13-16 and 18.

Respectfully submitted,
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